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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,889	11/16/2001	Jun Moroo	1075.1182	7568
21171	7590	07/06/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ISMAIL, SHAWKI SAIF	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/987,889

Applicant(s)

MOROO, JUN

Examiner

Shawki S. Ismail

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on April 19, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **RESPONSE TO AMENDMENT**

1. This communication is responsive to the amendment filed on April 19, 2005. Claims 1, 10, and 19-21 were amended. Claims 22 and 23 were newly added. Claims 1-23 are presented for examination.

### **The Old Rejection Maintained**

2. The rejection is respectfully maintained as set forth in the last Office Action mailed on January 19, 2005. Applicants' arguments with respect to claims 1-21 have been fully considered but they are deemed to be moot and old rejection is maintained.

### **Claim Rejections - 35 USC § 112**

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 22 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite, "categorizing the electronic message..." nowhere in the specification is there any mention or reference to the categorization of electronic messages as claimed in claims 22 and 23.

**Claim Rejections - 35 USC §102**

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1-7, 12-24, and 29-34, are rejected under 35 U.S.C. 102(e) as being anticipated by **Voticky et al.**, (Voticky) U.S. Patent No. **6,351,764**.

7. As to claim 1, Voticky teaches an electronic message delivery system comprising:

a terminal from which a user is able to browse electronic messages, electronically sent out on a communications network and addressed to the user (col. 2, line 64 – col. 3, line 9); and

an electronic message delivery management server for managing delivery of the electronic message delivery management server including:

(a) a permitted-sender list in which permitted-sender information about a permitted sender, whose every electronic message is permitted to be received by the user on said terminal, is registered (Fig. 3, col. 4, lines 14-24);

(b) sender information obtaining means for obtaining sender information from an individual electronic message addressed to the user (Fig. 3);

(c) checking means for checking as to whether or not said sender information, which has been obtained by said sender information obtaining means, of the lastnamed individual electronic message is identical with said permitted-sender information registered in said permitted-sender list (Fig. 2, col. 4, lines 41-50);

(d) delivering means for delivering said last-named electronic message, which contains said last-named sender information registered in said permitted-sender list, to the user if the result of the checking by said checking means is positive (col. 4, lines 55-62);

(e) a message holder for temporarily holding every electronic message from any sender so as to be browsed by the user from said terminal (col. 4, lines 55-62);

(f) storing control means for storing the last-named electronic message into said message holder if the result of the checking by said checking means is negative (col. 4, lines 55-62);

(g) browsing control means for allowing the individual electronic messages, which have been temporarily held in said message holder, to be browsed by the user from said terminal upon a browsing request of the user from said terminal (Fig. 3);

(h) link setting means for setting a link between said sender information of an individual electronic message, which has been temporarily held in said message holder, and said permitted-sender list while the user is browsing the last-named individual electronic message from said terminal (fig. 4); and

(i) registering means for registering said sender information of an electronic message in said permitted-sender list when the sender of the last-named electronic

message is selected as a newly permitted sender by the user from said terminal (col. 8, lines 35-45), and wherein said electronic message delivery management server distributes the electronic messages to said terminal, allows the individual electronic messages to be browsed by the user from said terminal upon the browsing request, sets the link between said sender information and said permitted-sender list, and registers said sender information in said permitted-sender list (see Fig. 4, col. 6, lines 18-33, col. 8, lines 35-45).

8. As to claim 2, Voticky teaches an electronic message delivery system according to claim 1, further comprising notifying means for notifying the user that an electronic message has been held in said message holder, if said message holder holds the last-named electronic message therein (col. 9, lines 32-46).

9. As to claim 3, Voticky teaches an electronic message delivery system according to claim 2, wherein said notifying means performs the notification of said last-named electronic message held in said message holder, at prescribed time intervals (col. 9, lines 32-46).

10. As to claim 4, Voticky teaches an electronic message delivery system according to claim 1, wherein said electronic message is an e-mail (Abstract, Fig. 1, col. 3, lines 49-51).

11. As to claim 5, Voticky teaches an electronic message delivery system according to claim 2, wherein said electronic message is an e-mail (Abstract, Fig. 1, col. 3, lines 49-51).

12. As to claim 6, Voticky teaches an electronic message delivery system according to claim 3, wherein said electronic message is an e-mail (Abstract, Fig. 1, col. 3, lines 49-51).

13. As to claim 7, Voticky teaches an electronic message delivery system according to claim 1, wherein said electronic message is a voice mail (Abstract, col. 8, lines 64-67).

14. As to claim 8, Voticky teaches an electronic message delivery system according to claim 2, wherein said electronic message is a voice mail (Abstract, col. 8, lines 64-67).

15. As to claim 9, Voticky teaches an electronic message delivery system according to claim 3, wherein said electronic message is a voice mail (Abstract, col. 8, lines 64-67).

16. Claims 10-21 are essentially the apparatus and recording medium of the above-mentioned claim; therefore, they are rejected under the same rationale.

17. As to claim 22 Voticky teaches a method of managing an electronic message, comprising:

categorizing the electronic message in accordance with stored sender information upon receipt of the electronic message by a server (see Fig. 3, mail is prioritized or categorized according to the assigned codes); and

automatically transmitting a notification related to the categorized electronic message to a terminal, and enabling a user of the terminal to link sender data of the categorized electronic mail to the stored sender information while browsing contents of

the electronic message (Fig. 4 and (col. 9, lines 32-46, the user is then presented with the categorization of the electronic messages among different mailboxes) .

18. As to claim 23 Voticky teaches an apparatus for managing an electronic message, comprising:

means for categorizing the electronic message in accordance with stored sender information upon receipt of the electronic message by a server(see Fig. 3, mail is prioritized or categorized according to the assigned codes);

means for automatically transmitting a notification related to the categorized electronic message to a terminal means for enabling a user of the terminal to link sender data of the categorized electronic mail to the stored sender information while browsing contents of the electronic message (Fig. 4 and (col. 9, lines 32-46, the user is then presented with the categorization of the electronic messages among different mailboxes).

### **Response to Arguments**

19. Applicant's arguments filed on April 19, 2005 have been fully considered but they are not deemed to be persuasive.

Argument: Applicant argues in substance that Voticky does not teach or suggest an electronic message delivery management server for managing the delivering of the electronic messages, where the electronic message delivery management server distributes the electronic messages to a terminal, allows the individual electronic messages to be browsed by a user from the terminal upon a browsing request, sets the



link between said sender information and said permitted-sender list, and registers said sender information in said permitted-sender list

Response: Voticky teaches a method of sorting a received information message in which a source of delivery of the message is indicated by a unique identifier accompanying the message, for example, in an e-mail or voice message system. The method includes steps of receiving the message, looking-up the identifier in a database (the user's database is able to be updated with new or additional addresses from previously unlisted and unprioritized sources), assigning a code for the message per the result of the step of looking-up, and the user is then presented with the categorization of the electronic messages among different mailboxes (see Fig. 4, col. 6, lines 18-33, col. 8, lines 35-45) and; therefore, meets the scope of the claimed limitation.

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

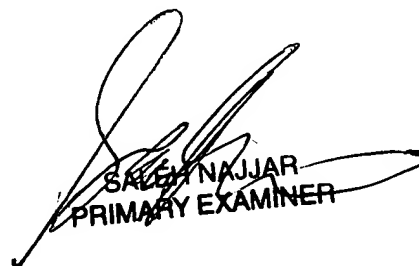
### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawki S Ismail whose telephone number is 571-272-3985. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shawki Ismail  
Patent Examiner  
June 29, 2005



SALEH NAJJAR  
PRIMARY EXAMINER